

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: BJORN LIEDTKE, JOACHIM GORDT,
ULRICH SPEER, JAMES WISE, WAN CHAI,
WILFRED SCHULL and HANS-GERD ESSER



Application No. 10/018,144

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on May 16, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

SUPPLEMENTAL EXAMINER'S ANSWER

The Communication mailed April 24, 2006, both acknowledges receipt of the Reply Brief received February 15, 2006, and serves as a Supplemental Examiner's Answer in response to the Reply Brief.

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In consideration of the Supplemental Examiner's Answer, mailed April 24, 2006, this application was prematurely forwarded to the Board of Patent Appeals and Interference, as appellant's period for response to the Supplemental Examiner's Answer does not expire until June 24, 2006.

EXAMINER'S ANSWER

On December 16, 2005, an Examiner's Answer was mailed, responding to the Appeal Brief filed September 21, 2005. A review of the Examiner's Answer reveals it is not in compliance with the Manual of Patent Examining Procedure, MPEP §1207.02 which states:

(8) Evidence Relied Upon

A listing of evidence relied on (e.g., patents, publications, admitted prior art), and in the case of non-patent references, the relevant page or pages.

Correction of the record is required.

APPEAL BRIEF

Appellant filed an Appeal Brief September 21, 2005. Accordingly, the Appeal Brief does not comply with the new rules that went into effect on September 13, 2004, under 37 CFR § 41.37(c).

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) ***Evidence appendix.*** An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) ***Related proceedings appendix.*** An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or with any appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

An review of the Appeal Brief filed September 21, 2005, indicates that the following sections are missing:

- 1) "Evidence Appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related Proceedings Appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

It is required that a substitute Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page

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entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the examiner to:

- 1) hold the Appeal Brief filed on September 21, 2005, defective;
- 2) to notify appellants to file a substitute Appeal Brief in compliance with 37 CFR

§ 41.37;

- 3) to vacate the Examiner's Answer mailed December 16, 2005;

- 4) to consider the substitute Appeal Brief and submit a revised Examiner's Answer

providing the required sections in accordance with the new rules effective September 13, 2004;

and

- 5) for such further action as may be appropriate.

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DALE M. SHAW
DEPUTY CHIEF APPEAL ADMINISTRATOR
(571) 272-9797

DMS/dpv

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Robert W. Becker & Associates
707 Highway 66 East
Suite B
Tijeras, NM 87059